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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	2164.004	2619

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LAW OFFICE OF RAY B. REGAN
P.O. BOX 1442
CORRALES, NM 87048

EXAMINER

KING, ANITA M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,655

Applicant(s)

LIEBENDORFER, JOHN E.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17, 18, 21-23, 31, 32 and 34-37 is/are rejected.
- 7) ☒ Claim(s) 11-16, 19, 20 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 19 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This is the third non-final office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

Election/Restrictions

Claims 24-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 19, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The drawings are objected to because reference numbers "66" and "70" appear to be referring to the same element. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitations "the following surface" in line 4 and "the leading surface" bridging lines 5 and 6. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,571,338 to Kadonome et al., hereinafter, Kadonome. Kadonome discloses a system for removably and adjustably mounting a device on a surface (30), comprising a rail (20) formed with at least two tracks (26); one or more clamps (50, 160, or 260) for connecting the system to the surface; wherein the at least two tracks include a channel the length of the rail; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the one or more clamps is formed as a duct with at least two opposing flanges; wherein the opposing shoulders of the one or

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more clamps are substantially perpendicular to one another; and wherein the one or more clamps include means for connecting the device to the rail.

Claims 1-3, 5, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,105,317 to Tomiuchi et al., hereinafter, Tomiuchi. Tomiuchi discloses a system for removably and adjustably mounting a device on a surface, comprising: a rail (60) formed with at least two tracks (@62); one or more clamps (30) for connecting the system to the surface; wherein at least two tracks include a channel extending the length of the rail; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the rail is formed with a body having a proximal end, a distal end, and a hollow chamber (61) therebetween; wherein the one or more clamps is formed as a duct with at least two opposing flanges; and wherein the one or more clamps includes means for connecting the device to the rail.

Claims 1-4, 8, 9, 10, 17, 18, 21, 22, 31, 32, and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,370,828 to Genschorek.

Genschorek discloses a system for removably and adjustable mounting a device on a surface, comprising: a rail (2) formed with at least two tracks; one or more clamps (3) for connecting the system to the surface; wherein at least two tracks include a channel extending the length of the rail; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the slot in one of the at least two tracks is formed at substantially a right angle to the slot in any other of the at least two tracks; wherein the one or more clamps (see Fig. 5) is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending

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member monolithically extending from the base in a direction substantially opposite the direction of the descending member; and wherein the one or more clamps include means for connecting (17) the device to the rail.

In regards to claims 10, 17, 21, and 22, Genschorek discloses an apparatus for positioning a module (1) on a surface, comprising: a footing grid, wherein the footing grid includes at least one keeper (4); at least one dual track rail (2) removably mountable on the footing grid; one or more clamps (3) variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid; wherein the one or more clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles from the plate (see Fig. 2); wherein the one or more clamps is formed with a leg having a base with first side and a second side, a descending member (13) monolithically extending from the first side a direction opposite a following surface, and an ascending member (5) monolithically extending from the second side in a direction opposite a leading surface (see Fig. 5); and wherein the ascending member further includes a projecting distally longitudinal fin (12) extending from the second side in the direction opposite the ascending member.

Allowable Subject Matter

Claims 11-16, 19, 20, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see remarks section, filed February 19, 2003, with respect to the rejection(s) of claim(s) 10 and 17 under 35 U.S.C. 102(b) as anticipated by Tourneux and Kadonome et al., respectively, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent no. 6,370,828 to Genschorek.

Applicant's arguments, in regards to Kadonome as applied to claims 1-3, 6, 7, and 9, filed February 19, 2003 have been fully considered but they are not persuasive. The rejection advanced against claims 1-3, 6, 7, and 9 as being anticipated by U.S. Patent No. 5,571,338 to Kadonome et al., stands.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the unique dual track rail in combination with the novel clamps permits slidable adjustment and readjustment of the location on a rail on which a module may be positioned) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 3,443,350 to Birum, Jr.

U.S. Patent 4,848,048 to Mairlot

U.S. Patent 5,092,087 to Kane et al.

Birum, Jr. discloses exterior batten assemblies for securing building facings to building superstructures. Mairlot discloses a curved glazed rove for use particularly as a greenhouse, and a method for the production thereof. Kane et al. disclose a framework for supporting the glass panels of a skylight.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3597 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Anita M. King
Primary Examiner
Art Unit 3632

June 2, 2003